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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,751	12/21/2001	Kenneth L. Levy	P0530	2711

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DIGIMARC CORPORATION
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BEAVERTON, OR 97008

EXAMINER	
BROWN, ALVIN L	
ART UNIT	PAPER NUMBER
3622	

MAIL DATE	DELIVERY MODE
04/01/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/028,751	LEVY ET AL.	
	Examiner	Art Unit	
	ALVIN L. BROWN	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10/19/2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *5-7 and 9-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *5-7 and 9-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. The following is a Non-Final, First Office Action on the merits. Claims 5-7 and 9-12 are pending.

Election/Restrictions

2. Applicant's election without traverse of Group II: claims 5-7 and 9-12 in the reply filed on September 13, 2007 is acknowledged.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 10 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Abecassis (6,553,178 B2).

As per claim 10, Abecassis discloses a method comprising:

rendering video content to a user, the video content including promotional content integrated therein, rather than interrupting same (column 44, lines 46-67; column 45, lines 10-18);

receiving a signal from a user interaction device indicating selection of the promotional content (column 45, lines 10-18);

in response to said selection, providing to said user additional promotional information related to the selected promotional content (column 45, lines 30- 57); and

providing the user a reward for receiving said additional promotional information (column 48, lines 15-21).

As per claim 11, Abecassis further discloses the reward includes promotional points redeemable for premiums (column 48, lines 37- 50).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 5, 7, 9, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abecassis (6,553,178 B2) in view of Collart (6,405,203 B1).

As per claim 5, Abecassis discloses a method to skip advertisement which changes the cost of the video downloaded by the viewer (column 44, lines 46-67; column 39, line 53 - column 40, line 16).

Abecassis does not explicitly disclose a video content having a digitally watermarked promotional message therein, and sensing same when rendered at a user device.

Further, applicant discloses in the background of the invention that watermarking to encode digital content is well know in the art identifying digital media (paragraphs [0003 – 0005]. One such example is Collart's use of watermark in a video containing advertisement.

Collart discloses a video content delivery method, including providing video content having a digitally watermarked promotional message therein, and sensing same when rendered at a user device (column 32, lines 41-67; claim 5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Collart's video with a digital watermark to Abecassis' ability to skip advertisements. One would be motivated to do this in order to track consumers' exposure to advertisers' promotional material which serve to justify their investment.

As per claim 7, Collart discloses a method of video content delivery, including providing video content having plural digitally watermarked promotional messages therein, and sensing same when rendered at a user device, wherein sensing of one or more of said watermarked messages entitles a user to access other content or capabilities (column 21, lines 17-42; column 31, lines 9-52).

As per claim 9, Abecassis discloses a method to subsidize video content with the viewing of advertisement. Abecassis further discloses a viewer receiving a video free of charge (column 48, lines 37-41); and

triggering a payment to the content proprietor (column 45, lines 19-24).

Abecassis does not explicitly disclose:

detecting a digital watermark in the rendered video content; and

rendering the video content for viewing.

Further, applicant discloses in the background of the invention that watermarking to encode digital content is well know in the art identifying digital media (paragraphs

[0003 – 0005]. One such example is Collart's use of watermark in a video containing advertisement.

However, Collart teaches detecting a digital watermark in the rendered video content (column 31, lines 9-39, lines 58-64; column 32, lines 41-67); and

rendering the video content for viewing (column 32, lines 41-67).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Collart's video with a digital watermark to Abecassis' ability to provide content free to viewers and in other cases providing payment to the content proprietor. One would be motivated to do this in order to track consumers' exposure to advertisers' promotional material which serve to justify their investment.

As per claim 12, Abecassis further discloses additional promotional information is provided to the user (column 45, lines 10-29).

Abecassis does not explicitly disclose a process that makes use of digital watermark information conveyed in said video content.

Further, applicant discloses in the background of the invention that watermarking to encode digital content is well know in the art identifying digital media (paragraphs [0003 – 0005]. One such example is Collart's use of watermark in a video containing advertisement.

However, Collart discloses a video content delivery method, including providing video content having a digitally watermarked promotional message therein, and sensing same when rendered at a user device (column 32, lines 41-67; claim 5).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Collart's video with a digital watermark to Abecassis' ability to skip advertisements. One would be motivated to do this in order to track consumers' exposure to advertisers' promotional material which serve to justify their investment.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Abecassis (6,553,178 B2) in view of Collart (6,405,203 B1) and further in view of Itoh et al. (2003/0206632 A1).

As per claim 6, The Abecassis and Collart combiantion discloses the claimed invention of claim 5. The combination does not explicitly disclose the changed terms include assessing a charge for skipping the promotional message.

Abecassis further discloses a viewer's ability to skip advertisements by using the skip key and crediting/debiting the user's account based on viewing of selected advertisement.

However, Itoh teaches a charge for skipping commercials (paragraph [0059, 0060]).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add Itoh's charge for skipping commercials to Abecassis and Collart's video with watermark and ability to skip advertisements. One would be motivated to do this in order to track consumers' exposure to advertisers' promotional material which serve to justify their investment.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Goldhaber et al (5,794,210) discloses a method to provide incentives to consumer to view advertisements. Scott et al. (6,338,094 B1) discloses a video with a watermark.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALVIN L. BROWN whose telephone number is (571)270-5109. The examiner can normally be reached on Monday - Thursday 7:30 AM to 5:00 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on 571 272 6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ALB

/Arthur Duran/

Primary Examiner, Art Unit 3622

3/27/08